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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,031	10/24/2005	Josef Laumen	112740-1059	9038
29177 7590 09/17/2007 BELL, BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER BROOKS, SHANNON	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 09/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,031

Applicant(s)

LAUMEN ET AL.

Examiner

Shannon R. Brooks

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 27-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/24/07 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 27-32 and 37-42** are rejected under 35 U.S.C. 102(b) as being anticipated by Lehmus (WO9833343).

Consider **Claim 27**, Lehmus teaches a method for providing pre-paid services over a radio communication network to a telecommunication device comprising a user identification circuit,

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the method comprising the steps of: communicating a user identification message from the user identification circuit to the telecommunication device, (Fig. 4c, Pg. 4, [6]-[8] and Pg. 5, [1]); transmitting at least one service request message over the radio communication network from the user identification circuit to a service computer, wherein the at least one service request message requests allocation of at least one service (read as SMS or USSD message, Fig. 4c, Block 41 and Pg. 4, [6]-[8] and Pg. 5, lines 1-12); receiving a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message, wherein the user identification circuit evaluates the pre-paid account status message (read as server verifies user's creditworthiness so that prepaid card can be debited, Pg. 4, [8]-Pg. 5, line 12); communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result (read as creditworthiness is verified ,Pg. 4, [8]-Pg. 5).

Consider **Claim 28**, Lehmus teaches the method, wherein the telecommunication device is one of a GSM device and a UMTS device (Pg. 4, [1]).

Consider **Claim 29**, Lehmus teaches the method, wherein the user identification circuit is one of a Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM) (Pg. 4, [1], [4]-[7]).

Consider **Claim 30**, Lehmus teaches the method, wherein the service request message is generated by a command set on an application toolkit stored in one of the Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM) (Pg. 4, [8]-Pg. 5, line

12).

Consider **Claim 31**, Lehmus teaches the method, wherein the at least one service request message is transmitted concurrently with the communication of the user identification message (Pg. 4, [8]-Pg. 5, [1]).

Consider **Claim 32**, Lehmus teaches the method, wherein the specific result is an indication that sufficient pre-paid credit is available (Pg. 4, [8]-Pg. 5, line 12).

Consider **Claim 37**, Lehmus teaches the method, further comprising the step of blocking allocation (read as denying access) of the requested service if the evaluated pre-paid account status message does not indicate the specific result (Pg. 4, [8]-Pg. 5, line 12).

Consider **Claim 38**, Lehmus teaches the method, wherein the service computer is a server (Pg. 4, [8]-Pg. 5, line 12).

Consider **Claim 39**, Lehmus teaches an apparatus that allocates pre-paid services over a radio communication network, comprising:
a telecommunication device (Figs. 1-3); and a user identification circuit, wherein the user identification circuit communicates a user identification message to the telecommunication device (Pg. 4, [1], [4]-[7]), and transmits at least one service request message over the radio communication network to a service computer, wherein the at least one service request message requests allocation of at least one service (Pg. 4, [8]-Pg. 5, line 12), and wherein the user identification circuit receives a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message (read as server allows or denies service, Pg. 4, [8]-Pg. 5, line 12), wherein the user identification circuit evaluates the pre-paid account status message (read as user informed as

to whether credit is an issue, Pg. 4, [8], Pg. 5, line 12), wherein the user identification circuit communicates the evaluated pre-paid account status message to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result (read as allow use when the user is creditworthy, Pg. 4, [8]-Pg. 5, line 12).

Consider **Claim 40**, Lehmus teaches the apparatus, wherein the telecommunication device is one of a GSM device and a UMTS device (Pg. 4, [1]).

Consider **Claim 41**, Lehmus teaches the apparatus, wherein the user identification circuit is one of a Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM) ~) (Pg. 4, [1], [4]-[7]).

Consider **Claim 42**, Lehmus teaches the apparatus wherein the service request message is generated by a command set on an application toolkit stored in one of the Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM) (Pg. 4, [8]-Pg. 5, line 12).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claim 33** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmus in view of Sivula (US 6907239 B1).

Consider **Claim 33**, Lehmus teaches the method, but Lehmus fails to specifically teach the method wherein the service is at least one of mobile email, instant messaging, video telephony, a multimedia messaging service and a short message service.

However, Sivula teaches the method wherein the service is at least one of mobile email, instant messaging, video telephony, a multimedia messaging service and a short message service (Col. 6, lines 58-67).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teaching of Lehmus and Sivula in order to convey a list of services (Col. 6, line 61).

7. **Claims 34 and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmus in view of Capitant (US 6976011 B1).

Consider **Claim 34**, Lehmus teaches the method, but Lehmus fails to specifically teach the method wherein and the at least one service request message contains, depending upon a type of requested service, additional data required for providing the service.

However, Capitant teaches the method wherein and the at least one service request message contains, depending upon a type of requested service, additional data required for providing the service (read as buyer's authentication, Col. 3, lines 44-57).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teaching of Lehmus and Capitant in order to aid in security (Col. 3, lines 44-57).

Consider **Claim 35**, Lehmus teaches the method, wherein each service request message includes parameters for charges, depending on the type of service being requested (read as determining creditworthiness, (Pg. 4, [8]-Pg. 5, line 12).

8. **Claim 36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmus in view of Capitant (US 6976011 B1) and further in view of Sivula (US 6907239 B1).

Consider **Claim 36**, Lehmus teaches the method , but Lehmus fails to specifically teach the method wherein the at least one service request message describes an order of the services requested by the radio communication terminal.

However, Sivula teaches the method wherein the at least one service request message describes an order of the services requested by the radio communication terminal (Col. 6, lines 17-44).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teaching of Lehmus and Sivula in order to aid in item selection (Col. 6, lines 17-44).

Conclusion

9. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon Brooks whose telephone number is (571) 270-1115.

The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shannon R. Brooks

September 10, 2007



CHARLES N. APPIAH
SUPERVISORY PATENT EXAMINER